

Applicant merely proposes to set up an electronic market similar to or the same as the NASDAQ market for selling, buying, or exchanging the right to bandwidth components, treated as commodities, in a manner similar to that employed in the NASDAQ Market for selling, buying, and exchanging other commodities. To the extent that: there is not admission to the claim scope [emphasis added; see definitions provided by remarks of Amendment B] of division of bandwidth resources representing bandwidth securitization and transferring the instrument thereof it would have been obvious to one having ordinary skill in the art because it is merely another commodity. It should be understood that it would be obvious to provide for any commodity on a well known market. Futures, options, electricity, water, and the like [are] priced, bought and sold by electronic systems as common place.

Office Action, Pages 2-3. Applicant respectfully disagrees.

In order for a claim to be rejected as rendered obvious over a reference or combination of references, a prima facie case of obviousness must be established. In order to do this, at least two criteria must be met. First, there must be some motivation or suggestion to make the proposed combination or modification of the references. Further, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicant's disclosure (citations omitted). Additionally, the references, when combined, must teach or suggest all claim limitations.

Applicant submits that there is no evidence of motivation to make the proposed modification of the admitted prior art. According to the MPEP,

[i]n order to support a conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references.

MPEP 2142 (citing Ex parte Clapp, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added). Further, "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." MPEP 2142 (citing Ex parte Skinner, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1988).

The Office Action has not explained why the modification of the admitted prior art is proper, and there is no suggestion in the admitted prior art to make such a modification. The present invention is directed to creating a trading instrument that breaks bandwidth

resources into discrete, usable component pieces, and allows an electronic market system to set a price for the commodity. See Appl'n, Page 38. The admitted prior art, on the other hand, is directed to the NASDAQ Market, in which commodities are traded. In this market, a finite number of "titles" are traded. According to the specification, "NASDAQ is primarily an electronic bulletin board where market makers advertise at what prices they are willing to buy and sell a particular security. These market makers maintain an inventory of tradeable securities for sale to other parties, whether agency or principal-based transactions." See Appl'n, Page 32. These commodities are not component parts of a larger whole; that is, each commodity traded as its own discrete, individual unit. There is no suggestion in the admitted prior art that the commodities traded should be divided into a plurality of component units, such as is recited in claim 3.

Similarly the Office Action has failed to present the requisite "convincing line of reasoning" as to why such a modification to the admitted prior art is proper. The Office Action seems to assert that because bandwidth is a commodity, a commodity not contemplated by NASDAQ, it would be obvious to trade it over a market exchange. It appears that the Office Action is relying on impermissible hindsight to make this rejection. Therefore, in the absence of evidence to make the proposed modification, Applicant respectfully requests that the rejection be withdrawn.

Assuming arguendo that there is evidence of motivation to make the proposed combination, the modified reference fails to disclose or suggest all claim limitations. Claims 3-6 recite, inter alia, the step of "dividing a total bandwidth resource into a plurality of component bandwidth resource units." Appl'n, Claim 3. As discussed above, the admitted prior art does not disclose this step. Thus, in view of this difference, the admitted prior art does not disclose or suggest all claim limitations.

Claims 16-22 are dependent on claims 3-6, which Applicant maintains are nonobvious. According to the MPEP, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is also nonobvious." MPEP 2143.03, quoting In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that these rejections be withdrawn.

2. Claim 21

Claim 21 was not rejected or objected to by this Office Action. Therefore, Applicant maintains that this claim is allowable.

CONCLUSION

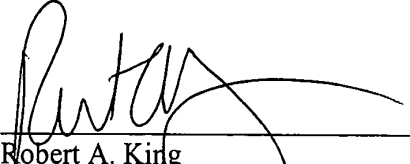
Applicant maintains that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representative, either by telephone or in person, would further prosecution of this application, we would welcome the opportunity for such an interview.

Respectfully submitted,

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